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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/566,583  | 01/31/2006  | Futoshi Kameda       | 040894-7382         | 5113             |
| 9629 7590 05/28/2009<br>MORGAN LEWIS & BOCKIUS LLP<br>1111 PENNSYLVANIA AVENUE NW<br>WASHINGTON, DC 20004 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| LOW, LINDSAY M  |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 3721  |             |                      |                     |                  |
| MAIL DATE   |             | DELIVERY MODE        |                     |                  |
| 05/28/2009  |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/566,583

**Applicant(s)**

KAMEDA, FUTOSHI

**Examiner**

LINDSAY M. LOW

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3, 5-7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-7 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is in response to applicant's RCE received on April 17<sup>th</sup>, 2009.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3, 5-7, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 6 recite the limitation "the upper surface of the pusher." There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 5-6, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Oliver (4,671,444).

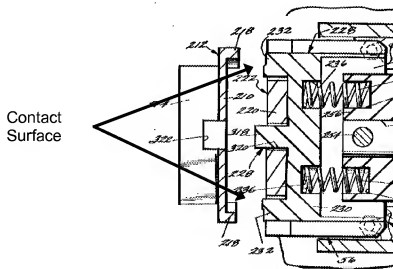
Oliver discloses the same invention including a driver 22, a magazine accommodating connected staples, a guide surface 212, a pusher 56 that presses a leading end staple and the next staple to the guide surface (see col. 14 lines 28-42).

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The staples have an upper portion extending lengthwise having first and second portions extending perpendicularly from the upper portion. The pusher 56 has a support surface 316 that contacts a lower surface of the center of the upper portion of the leading staple when the driver 22 moves down (see col. 13 line 62 - col. 14 line 2). Lower surfaces of the upper portions of the next staple and continuing staples are in contact with an upper surface 302 of the pusher 56. A protrusion 318 has a surface 316 that slopes in a driving direction of the driver. There is no gap between the upper surface 302 and the protrusion surface 316.

Regarding claims 5 and 9, when the driver 22 moves downward, the upper portion of the staple moves to the sloping surface 316 and the pusher 56 retreats in a direction opposite to the guide surface (col. 14 lines 1-2).

Regarding claim 6, the pusher 56 includes a contact surface (designated below) for pressing the leading staples to the guide surface 212.



***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oliver (4,671,444) in view of Kufel (3,029,436).

Oliver discloses the same invention substantially as claimed except for having a pair of legs on the driver. Instead, Oliver has legs 232 on the pusher 228 and has a flat ended driver. However, Kufel teaches a driver 22 having a pair of legs 32 for engaging the staple legs. Kufel states in col. 3 lines 1-7 that forming the driver 22 and legs 32 as one piece is an economical type of construction. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a pair of legs on Oliver's driver for the purpose of creating an economical type of construction for the stapler.

***Response to Arguments***

8. Applicant's arguments with respect to the upper surface of the pusher contacting the continuing staples have been considered but are moot in view of the new ground(s) of rejection.

Applicant contends that Kufel does not teach a pair of leg portions on a driver, and instead teaches the leg portions on a former adjacent the driver. However, it

should be noted that the leg portions 32 of Kufel are in fact located on the driver 22 (see Fig. 7). Note that Kufel states in col. 2 line 72 through col. 3 lines 1-2 that the leg portions 32 and driver 22 are formed from a single piece of metal and that the leg portions are part of the driver that is bent upon itself. Therefore, Kufel's leg portions 32 are certainly considered to be part of the driver.

Applicant contends that Oliver has a gap between the upper surface of the pusher and the protrusion surface. However, it should be noted that claims are given their broadest reasonable interpretation consistent with the specification. In this instance, the claims state that "there is no gap between an upper surface of the pusher and the protrusion surface." Referring to Fig. 14 of Oliver, note that protrusion surface 316 is located on part 28 of pusher 56. Part 228 contacts a surface within element 222 with no gap. Surface 302 is located on element 222. Therefore, there is no gap between protrusion surface 316 and upper surface 302.

For the reasons above, the grounds of rejection are deemed proper.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINDSAY M. LOW whose telephone number is (571)272-1196. The examiner can normally be reached on Monday thru Friday 7:30 to 5:00.

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10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. M. L./  
Examiner, Art Unit 3721

/Rinaldi I Rada/  
Supervisory Patent Examiner, Art Unit 3721  
5/26/2009